



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,903	08/06/2001	Tomihiko Azuma	048369-0126	8837

22428 7590 04/21/2004

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

MAMMEN, NATHAN SCOTT

ART UNIT

PAPER NUMBER

3671

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/921,903

Applicant(s)

AZUMA, TOMIHIKO

Examiner

Nathan S Mammen

Art Unit

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3671

DETAILED ACTION

Election/Restrictions

1. This application contains claims 2, 3, 5, 6 drawn to an invention nonelected with traverse in Paper No. 5. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC §§ 102, 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 4, 7 are rejected under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 6,535,880 to Musgrove et al. or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 6,535,880 to Musgrove et al. in view of U.S. Patent No. 6,460,020 to Pool et al.

The Musgrove '880 patent disclose a sales and delivery support system. The system comprises a first means (20) in which the seller terminal (40) sends to the purchaser terminal

Art Unit: 3671

(12) product information and delivery agent information (i.e., shipping method – col. 6, line 59).

In the e-commerce art, selecting the shipping method inherently includes and implicates selecting a delivery agent. The system comprises a second means (24) in which the seller terminal receives the information from the purchaser regarding products the purchaser specifies to order and a purchaser specified delivery agent and generates purchase order identification information to identify the purchaser and for use to deliver the ordered product. The system further comprises a third means (col. 7, lines 21-30) for sending the purchase order identification information to the purchaser terminal and the delivery agent terminal.

Regarding claim 4: The system further comprises a means (col. 7, lines 30-36) in which the delivery agent terminal compares purchase order information received from the purchaser with that received from the seller and verifies the coincidence of the information.

Regarding claim 7: The Musgrove '880 patent discloses that a purchaser selects a plurality of products from a plurality of merchants. Col. 7, lines 21-26. The purchaser then specifies the delivery agent for those products.

While it is believed that the Musgrove '880 patent discloses each limitation, either explicitly or inherently, in the alternative, the claimed invention is obvious over the Musgrove '880 patent in view of the Pool '020 patent. The Pool '020 patent teaches that it is known in the art to a client to choose shipping options. Col. 7, lines 42-44. Those shipping options include selecting from carriers such as FedEx, UPS. Col. 12, line 5. Even assuming the Musgrove does not disclose specifying a shipping agent, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the Musgrove '880 patent with the ability

Art Unit: 3671

to select a shipping agent as taught by the Pool '020 patent, in order to allow a purchaser to specify an optimum shipping agent for the purchaser's needs.

Response to Arguments

5. Applicant's arguments filed 12/18/03 have been fully considered but they are not persuasive.

Applicant concedes that "shipment method", as stated by Musgrove, is a short-hand way of referring to "how the product is to be sent" and includes "second day delivery, ground transportation and the like." Argument, page 8. However, Applicant mistakenly tries to limit what is inherently meant by selecting a "shipment method". Inherently, selecting a shipping method means also selecting a delivery agent for that shipping method. For example, if a shopper specifies a product to be sent to a P.O. Box (see Musgrove, col. 6, line 59 – selecting a "shipping address), then the shopper would have to select U.S. Postal Service as the shipping agent. But beyond this example, it is inherent in the e-commerce art that selecting a shipping agent means selecting a delivery agent, e.g., U.S. Postal Service, Federal Express, United Parcel Service.

No expressed limitations of claim 4 were ignored. The shopping server computer, which includes the means for selecting the delivery agent, compares information inputted from the purchaser with information from the seller. Col. 7, lines 30-35.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

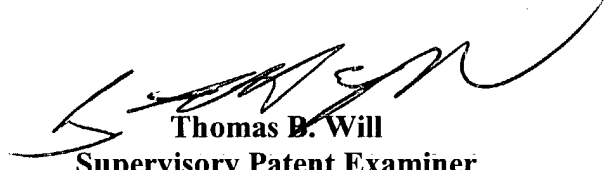
Art Unit: 3671

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Mammen whose telephone number is (703) 306-5959. The examiner can normally be reached Monday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will, can be reached at (703) 308-3870. The fax number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-1113.



Thomas B. Will
Supervisory Patent Examiner
Group 3600

NSM
4/19/04

Nathan S. Mammen